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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. McGARVEY¹

Appeal 2007-3320
Application 09/759,475
Technology Center 2600

Decided: January 29, 2008

Before JAMESON LEE, RICHARD TORCZON, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

1 DECISION ON APPEAL

2A. Statement of the Case

3 This is a decision on appeal by an Applicant under 35 U.S.C. § 134(a)
4 from a final rejection of claims 1-4, 6, 9, 12-21, 27-30, and 32. We have
5 jurisdiction under 35 U.S.C. § 6(b).

6

²¹ The real party in interest is Eastman Kodak Company.

5

1

References Relied on by the Examiner

2

3D'Luna US 5,008,739 Apr. 16, 1991

4Suzuki US 5,691,772 Nov. 25, 1997

5Thadani US 6,201,530 Mar. 13, 2001

6

7Thorpe and Takeuchi *The All-Digital Camcorder – The Arrival of*
8*Electronic Cinematography*, SMPTE Journal, Vol. 105, No. 1, 13-30 (1996)
9(hereinafter “Thorpe”)

10

11

The Rejections on Appeal

12

13 The Examiner rejected claims 1, 3, 4, 6, 9, 12, 15-20, 27-30, and 32
14under 35 U.S.C. § 103(a) as unpatentable over Thorpe and Suzuki.

15 The Examiner rejected claims 2 and 14 under 35 U.S.C. § 103(a) as
16unpatentable over Thorpe, Suzuki, and D'Luna.

17 The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as
18unpatentable over Thorpe, Suzuki, and Thadani.

19 The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as
20unpatentable over Thorpe and D'Luna.

21B. Issues

22 Has the Applicant shown error in the rejection of claims 1-4, 6, 9, 12-
2321, 27-30, and 32 under 35 U.S.C. § 103 as unpatentable over prior art?

24C. Summary of the Decision

25 The Applicant has not shown error in the rejection of any claim under
2635 U.S.C. § 103 as unpatentable over prior art.

27D Findings of Fact (Referenced as FF. ¶ No.)

28 1. The Applicant's invention is directed to a digital camera system
29which stores in the camera white balance settings for different venues, with a

1respective associated file identifier for each venue. (Spec. Summary of the
2Invention).

3 2. According to the Applicant, prior art systems only allow one
4setting to be stored, and the saved setting is erased and cannot be recalled
5once a new setting is stored. (Spec. 1:30 to 2:1).

6 3. Further according to the Applicant, photographers typically do
7not want to determine the proper white balance setting for a venue each time
8they want to take a picture at the venue. (Spec. 5:19-20).

9 4. That perceived problem, however, was already solved by the
10system disclosed in Thorpe.

11 5. Thorpe discloses a camera system which includes multiple
12removable electronic setup memory cards each one of which stores the
13complete control settings for a particular “image look.” (Thorpe 22:1:17 to
1423:3:5).

15 6. Thorpe states (Thorpe 24:1:7 to 24:3:10):

16 Rental houses and production facilities can prepare set-up
17 cards for a wide variety of such customized image-making
18 choices. Over a period of time involving various shooting
19 experiences, the particular look sought by a film
20 cinematographer or videographer can be readily supplied in the
21 form of an appropriately identified set-up card.
22

23 A major step in eliminating “video-tweaking” during
24 location shooting is provided by this unique electronic card
25 system, bringing the video camcorder a large step closer to the
26 adjustment-free operation of a film camera. Digital EC is thus
27 rendered more friendly to the skilled film cinematographer.
28

29 7. Independent claim 1 reads as follows:

1 Claim 1. A white balance picture correction process
2 implemented in a digital camera having a processor, a memory
3 and a user interface, comprising the steps of:
4

5 determining a white balance digital camera processing
6 setting for a picture taking venue at a visit to the venue;
7

8 saving the setting for the venue; and
9

10 correcting pictures taken at a subsequent visit to the
11 venue with the saved setting;
12

13 the determining step further comprising capturing an
14 image utilizing the digital camera and processing the captured
15 image in the processor of the digital camera to determine the
16 white balance setting;
17

18 the saving step further comprising storing the white
19 balance setting in the memory of the digital camera in a file
20 having an identifier which allows a user of the digital camera to
21 correlate the identifier with the venue;
22

23 the memory being configurable to store the determined
24 white balance setting and at least one additional white balance
25 setting for another picture taking venue, the determined white
26 balance setting being selectable from the plurality of stored
27 white balance settings, for use in the correcting step, via the
28 user interface of the digital camera.
29

30 8. The Examiner determined that Thorpe discloses each and every
31feature of claim 1 except the very last limitation of (See Ans. 3:7 to 4:4):²

32 the memory being configurable to store the determined
33 white balance setting and at least one additional white balance
34 setting for another picture taking venue, the determined white
35 balance setting being selectable from the plurality of stored
36 white balance settings, for use in the correcting step, via the
37 user interface of the digital camera.

14² This finding of the Examiner is not challenged by the Applicant.

1

2 9. Suzuki discloses a camera system with white balance
3adjustment abilities, including (1) a memory table 108M which stores the
4gain for fine weather, cloudy, and tungsten light sources, which is produced
5when white balance adjustment is set in manual mode, and (2) a memory
6table 108K which stores the gains for various fluorescent lamps used when
7fluorescent lamp manual mode is selected. (Suzuki 4:54-65).

8 10. Suzuki discloses that the supporting memory circuitry can be a
9random access memory or a read-only memory. (Suzuki 4:24-29).

10E. Principles of Law

11 Obviousness is a legal determination made on the basis of underlying
12factual inquiries including (1) the scope and content of the prior art; (2) the
13differences between the claimed invention and the prior art; (3) the level of
14ordinary skill in the art; and (4) any objective evidence of unobviousness,
15*Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). One with ordinary skill
16in the art is presumed to have skills apart from what the prior art references
17explicitly say. *See In re Sovish*, 769 F.2d 738, 743 (Fed. Cir. 1985). A
18person of ordinary skill in the art is also a person of ordinary creativity, not
19an automaton. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742
20(2007).

21 In *KSR International Co.*, 127 S.Ct. at 1742-43, with regard to
22motivation to combine teachings, the Supreme Court stated: “Rigid
23preventive rules that deny factfinders recourse to common sense, however,
24are neither necessary under our case law nor consistent with it.” In an
25obviousness analysis, it is not necessary to find precise teachings in the prior
26art directed to the specific subject matter claimed because inferences and

1creative steps that a person of ordinary skill in the art would employ can be
2taken into account. *See KSR International Co.*, 127 S.Ct. at 1741.

3 Also, motivation to combine teachings need not be expressly stated in
4any prior art reference. *In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006).

5There need only be an articulated reasoning with rational underpinnings to
6support a motivation to combine teachings. *In re Kahn*, 441 F.3d at 988.

7 The test for determining obviousness is not whether the features of
8one reference may be bodily incorporated into the system disclosed in
9another reference, but whether the collective teachings as viewed by one
10with ordinary skill in the art would have rendered the claimed subject matter
11obvious. *In re Wood*, 599 F.2d 1032, 1036 (CCPA 1979). A prior art
12reference must be considered for everything it teaches by way of technology
13and is not limited to the particular invention it is describing and attempting
14to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed.
15Cir.), cert. denied, 474 U.S. 843 (1985). A reference must be evaluated for
16all its teachings and is not limited to its specific embodiments. *In re Bode*,
17550 F.2d 656, 661 (CCPA 1977).

18 During examination, claim terms are given their broadest reasonable
19interpretation consistent with the specification. *In re Icon Health & Fitness*,
20*Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007). It is improper to read limitations
21from examples given in the specification into the claims. *Constant v.*
22*Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). The
23name of the game is the claim. *In re Hiniker Co.*, 150 F.3d 1367, 1369 (Fed.
24Cir. 1998).

1F. Analysis

2 As in any appeal, the Applicant as appellant bears the burden of
3demonstrating error in the rejections on appeal.

4 The independent claims are claims 1, 15, 21, 27, 28, 29, and 32. The
5Applicant has not argued the merits of any dependent claim separate from
6that of the independent claim from which it depends. The Applicant also has
7not argued the merits of any independent claim separately from that of other
8independent claims, except for claims 1 and 21. We discuss only claims 1
9and 21. Note that simply stating the features of a claim does not constitute
10an argument for separate patentability of that claim. Board Rule 37(c)(vii).

11 We focus our analysis on the contested limitations. *Aero Prods. Int’l,*
12*Inc. v. Intex Rec. Corp.*, 466 F.3d 1000, 1012 n.6 (Fed. Cir. 2006). First, the
13Applicant argues that because Thorpe’s system requires use of a plug-in
14setup card for each separate venue for picture taking, it not only fails to
15teach the claim limitation of storing the respective settings of multiple
16venues in the memory of the digital camera but teaches away from that
17feature (Br. 9:25 to 10:2). The argument is rejected.

18 Simply disclosing something different is not a “teaching away” in the
19sense of affirmatively advising not to take a certain approach or disclosing
20that a particular scheme is unworkable. At most, Thorpe just discloses a
21different scheme. In any event, we do not see why the three memory cards
22of Thorpe as shown in Figure 16b cannot all be deemed a part of the
23memory of the camera system if the user selects all of them for use with the
24camera. Claim 1 nowhere requires the memory of the camera to be on a
25single chip or a single memory card. During examination, claim terms are
26given their broadest reasonable interpretation consistent with the

1specification. *In re Icon Health & Fitness, Inc.*, 496 F.3d at 1379. Nothing
2in Applicant's specification defines camera memory as necessarily
3implemented as only a single chip or card. Indeed, Applicant's specification
4even regards the combination of internal memory 36 and removable memory
5card 32 collectively as the camera memory. In that regard, the specification
6states (Spec. 5:23-27):

7 The white balance setting for each venue is determined and
8 stored in a file named by the user. The file can be
9 created/located in the camera white balance memory 36 and/or
10 in the removable memory card 32 and duplicated on a separate
11 computer 38, such as a desktop computer, available to the user.
12

13Even if the disclosed embodiment regards only a single memory card as the
14camera memory, it is improper to read limitations from the specification into
15the claims. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d at 1571.
16The name of the game is the claim. *In re Hiniker Co.*, 150 F.3d at 1369.

17 Accordingly, Applicant's argument does not distinguish the invention
18of claim 1 from the disclosed camera system of Thorpe. Thus, the Applicant
19has not shown error in the rejection of claims 1-4, 6, 9, 12-20, 27-30, and 32.

20 We further discuss the issue, in the alternative, now assuming
21arguendo that a camera memory cannot comprise more than a single
22memory card. The Applicant correctly points out that Suzuki does not
23disclose the storing of multiple white balance settings, one for each venue, in
24a camera memory, but the storing of multiple generic and non-venue-
25specific factors useful for providing white balance correction at the time of
26taking a photograph. The Applicant also correctly points out that Suzuki
27does not appear to pre-store a white balance setting for any particular venue,
28but rather teaches that the white balance setting used to provide white

1balance correction is recomputed upon each visit to the venue based in part
2on the stored generic factors selected by the photographer. But those
3arguments are misplaced because the Examiner did not find Suzuki as
4disclosing that the setting for multiple venues are concurrently stored in the
5camera's memory.

6 The Applicant is under a mistaken impression that every single feature
7of a claimed invention must be found in one of the cited prior art references
8in an obviousness rejection. There is no such requirement. While it is true
9that in an anticipation rejection under 35 U.S.C. § 102 every claimed feature
10must be found within the four corners of a single prior art reference, for an
11obviousness rejection there is no corresponding rule that every claim feature
12must be found specifically within a reference. That should not be surprising
13because the issue is obviousness. That there are differences between the
14claimed invention and the prior art is already presumed. The inquiry under
1535 U.S.C. § 103 is whether the differences are such that the claimed
16invention as a whole would have been obvious to one with ordinary skill.

17 The level of ordinary skill in the art is reflected in the prior art
18references cited of record. In particular, Suzuki discloses that one with
19ordinary skill in the art would have known that the memory in a digital
20camera can be used to store a variety of setting control information useful
21for computing the proper setting at the time of taking of a photograph. For
22instance, Suzuki states (Suzuki 4:54-65):

23 A control table 108A for use in auto white balance is a
24 memory which in auto mode, along with processing the values
25 Rb/Gb and Bb/Gb as parameters, stores the gain of the variable
26 amplifier circuits 104R and 104B. A control table 108M for
27 use in manual white balance is a memory which stores the gain
28 for fine weather, cloudy, and tungsten light sources which is

1 produced when white balance adjustment device is set in a
2 manual mode. A control table 108K for use in fluorescent lamp
3 white balance situations is a memory to store the gains for the
4 kind of fluorescent lamp used in situations wherein fluorescent
5 lamp manual mode is selected.
6

7 One with ordinary skill is presumed to be skilled, *In re Sovish*, 769
8F.2d at 743, has ordinary creativity and is not an automaton. *KSR*
9*International Co.*, 127 S.Ct. at 1742. The Examiner reasoned (Ans. at 4)
10that in light of Suzuki's disclosure of storing a variety of white balance
11setting variable values in one memory, one with ordinary skill would have
12known or been led to storing the white balance setting of more than one
13venue on one memory. The idea conveyed by Suzuki is that a camera
14memory is useful for storing a variety of setting data. If the camera memory
15is useful for storing values corresponding to different selectable factors for
16computing the white balance at various venues when needed, why wouldn't
17it be useful for storing the setting of multiple venues if it is already known to
18predetermine the white balance setting for each venue? From the
19perspective of one with ordinary skill in the art, the answer is that of course
20it would. That is the rationale articulated by the Examiner. It is logical and
21reasonable. Motivation to combine teachings need not be expressly stated in
22any prior art reference. *In re Kahn*, 441 F.3d at 989. There need only be an
23articulated reasoning with rational underpinnings. *In re Kahn*, 441 F.3d at
24988. Here, there is. Storing the contents of plural camera memory cards all
25in one camera memory yields nothing more than a predictable result,
26eliminating the need to carry multiple memory cards.

1 Accordingly, on the above-stated alternative basis, the Applicant has
2not shown error in the rejection of claims 1-4, 6, 9, 12-20, 27-30, and 32.

3 As for claim 21, the Applicant relies on the same argument as that
4presented in connection with claim 1 and an additional argument, i.e., “that
5the set-up card system of Thorpe does not involve such assignment of file
6name identifiers via a user interface of a digital camera” (Br. 17:18-19).
7 The argument completely ignores this statement of the Examiner in the final
8Office action specifically with regard to claim 21 (Final Rej. 20:1-2):

9 Official Notice is taken that a camera comprises a user
10 interface for assigning file name identifiers to the settings.
11
12In the Answer, the Examiner again reiterated the official notice relied
13upon for the rejection of claim 21 (Ans. 20:1-2). The Applicant filed
14no reply. Applicant’s failure to challenge the above-noted official
15notice taken by the Examiner renders unpersuasive the argument that
16the feature is not disclosed by Thorpe or met by the combination of
17Thorpe and D’Luna.

18 The Applicant has not shown error in the rejection of claim 21.

19G. Conclusion

20 The rejection of claims 1, 3, 4, 6, 9, 12, 15-20, 27-30, and 32 under
2135 U.S.C. § 103(a) as unpatentable over Thorpe and Suzuki is **affirmed**.

22 The rejection of claims 2 and 14 under 35 U.S.C. § 103(a) as
23unpatentable over Thorpe, Suzuki, and D’Luna is **affirmed**.

44Appeal 2007-3320
45Application 09/759,475
46

1 The rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable
2over Thorpe, Suzuki, and Thadani is **affirmed**.

3 The rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable
4over Thorpe and D'Luna is **affirmed**.

5 No time period for taking any subsequent action in connection with
6this appeal may be extended under 37 C.F.R. § 1.136(a).

7

AFFIRMED

MAT

cc: First Class Mail

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